

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT R. BLY

Appeal No. 1998-1847
Application No. 08/540,095

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5 to 10, 12 to 15 and 17, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claim 1 was amended subsequent to the final rejection.

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BACKGROUND

The appellant's invention pertains to the art of patient care products and more particularly to a transfer bench (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1, 5 to 10, 12 to 15 and 17 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 6, mailed June 3, 1997) and the answer (Paper No. 12, mailed January 7, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed December 8, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We do not sustain the rejection of claims 1, 5 to 10, 12 to 15 and 17 under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

The basis for the examiner's enablement rejection of the claims under appeal is set forth on page 4 of the answer as follows:

The structure of the "snap buttons" (110) is unclear to enable practicing the invention. No disclosure could be found which directs one on how to construct a "snap button" that passes through "openings" as claimed. Appellant's "openings" are actually each a pair of aligned openings formed cooperatively by the seat recesses (90,92) and respective frame members (40,42). The selective retraction is neither disclosed in, nor understood from, the instant disclosure.

The appellant argues (brief, pages 5-7) that a snap button is a conventional structure and that one skilled in the art when reviewing the disclosure in its entirety would understand precisely how to make and use the claimed structure.

The examiner's response (answer, pages 4-5) to the appellant's argument is as follows:

Appellant argues at pages 5-7 of the brief that one of ordinary skill in the art would understand what the disclosed snap buttons are and how they operate, per se. The examiner agrees, however, how such snap buttons operate in connection with the instant invention would not be understood by one of ordinary skill in the art. The disclosed snap buttons are known as cooperating with axially aligned openings formed in a pair of telescopic, tubular members, as illustrated in appellant's Fig. 1 relating to snap buttons 20, for example. No such telescopic, tubular members with cooperating, axially aligned openings have been disclosed relating to legs 94,96 and seat 60 in the instant disclosure. It is further noted appellant has not offered any reasoning as to how the snap buttons 110 are effective in performing the intended function.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention

without undue experimentation. The appellant's disclosure describes the claimed "snap buttons" on page 8 of the specification and shows the claimed "snap buttons" in Figures 1 and 3. From this disclosure, it is clear to us that each terminal end 104, 106 of the seat back mounting members 94, 96 receives a snap button 110 biased outwardly by a spring 112 to preclude removal of the seat back 100 once the terminal ends 104, 106 have been advanced entirely through their respective openings in the seat portion of a seat. The appellant's disclosure describes the claimed "openings" on page 7 of the specification and shows the openings in Figures 1 and 2. From this disclosure, it is clear to us that the claimed "openings" can be formed entirely within the seat portion, if so desired, or the openings defined in whole or in part, by recessed areas in the frame assembly, or the openings can consist of a pair of recesses 90, 92 formed in the lower surface of the seat portion which cooperate with the frame assembly to define the openings.

It is our determination that this disclosure would have enabled a person of ordinary skill in the art to make and use

the claimed invention. In that regard, it is clear to us that the claimed "snap buttons" pass through the claimed "openings" as follows: The snap buttons are depressed against the force of

the springs thus permitting the terminal ends of the seat back mounting members to be inserted into the openings and the terminal ends of the seat back mounting members are advanced entirely through the openings such that the force of the springs are now able to extend the snap buttons thus fixing the seat back in place. While in the embodiment of the openings shown in Figures 1 and 2 the snap buttons appear to be oriented downwardly such that they would automatically extend upon passing the rear bench leg 12 and thus the snap buttons would need to be depressed again to pass the front bench leg 10, we believe that even this embodiment of the openings is enabled.

For the reasons set forth above, we conclude that appellant's disclosure would have enabled a person of ordinary skill to make and use the appellant's invention without undue experimentation.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5 to 10, 12 to 15 and 17 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
Administrative Patent Judge)	

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